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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,506	01/31/2002	Case C. Grogan	003/243/SAP	5120

7590 08/12/2004

ATTN: MCMR-JA (Ms. Elizabeth Arwine- PATENT ATTY)  
U. S. Army Medical Research and Materiel Command  
504 Scott Street  
Fort Detrick, MD 21702-5012

EXAMINER	
PARK, HANKYEL	
ART UNIT	PAPER NUMBER
1648	

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/066,506	<b>Applicant(s)</b> GROGAN ET AL.	
	<b>Examiner</b> Hankyei T. Park	<b>Art Unit</b> 1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 1-18, 29-31 and 35-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-28 is/are rejected.
- 7) ☐ Claim(s) 19-28, 32-34 and 49-52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

Applicant's election with traverse of Group III in the reply filed on May 17, 2004 is acknowledged. The traversal is on the ground(s) that a complete search of art related to the recombinant DNA of Group III would necessarily cover the art related to the DNA fragments of Group II, the host cell transformed with the recombinant DNA construct of Group VII, the self-replicating RNA of Group IV, the infectious alphavirus particles of Group V, and the expressed chimeric filovirus protein of Group I. In addition, the traversal is on the ground that the prosecution of the inventions of Groups I, II, IV, V and VII together with the elected Group III would not place added demands on the Examiner. This is not found persuasive except for Group GII because the search for the recombinant DNA of Group III would not necessarily cover the art related to the DNA fragments, the self-replicating RNA, the infectious alphavirus particles and the expressed chimeric filovirus protein. The search for a recombinant DNA construct comprising a vector and a DNA fragment encoding a chimeric filovirus protein can be done without searching for a specific DNA sequence or a chimeric filovirus protein or an infectious alphavirus particles.

Except for Group VII, the requirement is still deemed proper and is therefore made FINAL. Examiner will rejoin Group VII with the elected Group III. The newly added claims 49-52 are drawn to the invention of elected Group III and will be examined accordingly.

***In Sum***

Claims 1-52 are pending; Claims 1-18, 29-31 and 35-48 are withdrawn as nonelected claims; Claims 19-28, 32-34 and 49-52 are examined.

***Claim Objections***

Claims 19-28, 32-34 and 49-52 are objected to because of the following informalities: Claim 19 depends on a nonelected claim, and the rest of the claims are objected to for depending on the objected claim 19. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 comprises an incorrect Markush language: the last element of the Markush group should be preceded by "and." Claims 21-28 are rejected for depending on the rejected claim 20.

***Conclusion***

Claims are deemed to distinguish over the prior art.

Claims 19-28, 32-34 and 49-52 are objected to.

Claims 20-28 are rejected.


No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hankyel T. Park whose telephone number is 571-272-0907. The examiner can normally be reached on 6:00 a.m. -2:00 p.m. Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached at 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HANKYEL T. PARK, PH.D  
PRIMARY EXAMINER